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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,548	09/15/2000	Nobuyuki Kita	019519-267	1924

7590 06/09/2003

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/662,548

Applicant(s)

KITA ET AL.

Examiner

Barbara Gilliam

Art Unit

1752

--The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Continuation of 5. does NOT place the application in condition for allowance because:

Applicant has not successfully demonstrated unexpected results. In the Declaration filed under 37 CFR 1.132 (3/27/03), Applicant demonstrated expected beneficial results. Please note that "Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof." In re Gershon, 372 F. 2d 535, 538, 152 USPQ 602, 604 (CCPA 1967). In the Declaration, 17,000 sheets of paper were printed using the printing plate of Example 6 comprising the overcoat layer and 12,000 sheets were printed using the printing plate of Example 1 which did not have the overcoat layer. It was concluded that the printing plate comprising the overcoat layer of Example 6 is hard to be stained and thus exhibits enhanced press life. As indicated in the rejection under 35 USC 103(a), one of ordinary skill in the art would expect protection from contamination from handling, improved suppression of odors during imaging and improved roll-up performance on press when the hydrophilic overcoat layer of Gardner, Jr. et al. is combined with the imaging element of Vermeersch et al. Plates protected from contamination (such as fingerprints and dust) have less stain upon printing. Therefore Applicant has shown what is expected based on the combined teachings of Gardner, Jr. et al. and Vermeersch et al.

Even if the results obtained were unexpected, Applicant has not demonstrated unexpected results over the entire claimed range. See MPEP 716.02(d), In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Applicant used a Heidelberg SOR-M printing machine in the declaration and in the original Examples of specification an entirely different printer was used, a Harris printer. In both Examples 1 and 6 of the specification, 10,000 sheets of clear prints were obtained.

B. Gilliam

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June 5, 2003


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